

### REMARKS

Claims 1-19 are pending upon entry of this amendment. Claims 6 and 7 have been amended and new claims 18 and 19 have been added. No new matter has been presented.

Claims 1-4, 8 and 11-14 are rejected under 35 USC 102(a) as being anticipated by Umabayashi. This rejection is respectfully traversed.

Claim 1 specifies that the “output form instruction information” includes an instruction that 1) relates to *an output form* of said image data and 2) is *specified by said image-related information*. The “output form,” as described in paragraph [0060] of the specification, refers to a designation of the “manner of output” of the image data. Paragraph [0060]. An example of the output form instruction information is the color information (e.g., color, monochrome, monochrome binary, etc.), which is specified by the image-related information (Fig. 4) and is included in the output form instruction information in relation to the output form of the image data (Fig. 5) to designate the manner in which the print data is outputted.

The Examiner asserts that Umabayashi’s disclosure of “receiving the instruction to print the selected image data along with the specified registration number of the selected image data” corresponds to this feature. Applicants respectfully disagree. The instruction to print the image data in Umabayashi refers to a designation of *where* the image data is to be outputted, rather than the output form of the image data as claimed, which designates *the form* in which the image data is to be outputted. Properties of image data, such as “image data size” and “image data format type” disclosed in col. 4, lines 19-29 of Umabayashi, are the properties of the image data itself and not specified by the print instruction to specify an output form of the image data. Furthermore, while the registration number of the image data in Umabayashi (which the Examiner compares to the claimed image-related information) is provided to the user, the print instruction form the user does not correspond to any instruction specified by the image-related information provided to the user. Umabayashi therefore fails to disclose or suggest the features of claim 1.

Claim 1 is allowable for these reasons. Claims 8 and 11 recite similar features as claim 1 and are similarly allowable. Claims 2-4 and 12-14 depend from claims 1 and 11 and are allowable for at least the same reasons.

New claim 18 depends from claim 1 and is allowable for at least the same reasons. Furthermore, claim 18 specifies that the image-related information comprises color information of the image data. This feature is supported by, e.g., Fig. 4 of this application. Umebayashi does not disclose or suggest providing color information of the image data to the user. Claim 18 is therefore allowable.

Claims 5-7, 9-10 and 15-17 are rejected under 35 USC 103(a) as being unpatentable over Umebayashi in view of Phillips. This rejection is respectfully traversed.

Claim 5 recites “an operation portion accepting a user input designating an external device as a sending destination of an abbreviated image to be prepared from said image data.” In the response of March 3, 2009, Applicants argued that in both Umebayashi and Phillips, the user’s device itself is the designated recipient of the image data and therefore neither reference discloses accepting a user input designating an external device as a sending designation. In response, the Examiner asserts that the Umebayashi discloses accepting a user designation of the external device (i.e., browser unit) in col. 4, lines 51-56. Applicants respectfully disagree.

Col. 4, lines 51-56 of Umebayashi discloses that the input device 10 includes a publication means 6 that is overlooked by the browser unit 30 of the user. In Umebayashi, the user transmits a request to the publication means 6 from the browser unit 30 and the publication means 6 transmits a screen data to the browser unit 30 in response. Therefore, as indicated in the previous response, the browser unit 30 in Umebayashi is the external device itself. There is no “user input designating an external device as a sending destination” in Umebayashi, as required by claim 5. Umebayashi therefore fails to disclose this feature.

Accordingly, claim 5 is allowable. Claim 9 recites a similar feature as claim 5 and is also allowable. Claims 6, 7 and 10 are allowable for their respective dependencies from an allowable claim.

New claim 19 recites that "the operation portion comprises a user interface provided on the image forming apparatus that accepts the user input designating the external device." This feature is supported by, e.g., Fig. 6, S10 of this application. The input device 10 of Umebayashi does not include a user interface that accepts the user input designating the external device. In fact, the input device 10 of Umebayashi only communicates with the user through the internet. Phillips does not overcome this deficiency. Claim 19 is therefore allowable.

Claim 15 recites that the sending portion sends output form instruction information including an instruction relating to an output from of the image data held in the image forming apparatus. As discussed above with reference to claim 1, this feature is not taught or suggested by Umebayashi. Phillips does not overcome this deficiency of Umebayashi. Claim 15 is therefore allowable.

In view of the above, this application is in condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. **325772033300**.

Dated: November 23, 2009

Respectfully submitted,

By   
Amir Rohani

Registration No.: 61,782  
MORRISON & FOERSTER LLP  
1650 Tysons Blvd, Suite 400  
McLean, Virginia 22102  
703.760.7757